



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,784	04/21/2006	Paul Adriaan Van Der Schaaf	LS/95-22963/A/PCT	5879
<div>324 7590 03/16/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005</div>			<div>EXAMINER CHENG, KAREN</div> <div>ART UNIT 1626 PAPER NUMBER</div>	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/16/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/576,784	VAN DER SCHAAF ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Karen Cheng	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/28/06</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

Claims 1-9 are currently pending in the instant application.

#### ***Lack of Unity Requirement***

Claims 1-9 are drawn to more than one inventive concept (as defined by PCT Rule 13), and accordingly, a restriction is required according to the provision set forth in PCT Rule 13.2.

PCT Rule 13.2 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention). PCT Rule 13.2 further states unity of invention as referred to in PCT Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. Special technical features, as defined in PCT Annex B, Part 1(b), include those technical features which define a contribution over the prior art.

PCT Annex B, Part 1(e) provides combinations of different categories of claims and states:

"The method for determining unity of invention under Rule 13.2 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

- (i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or
- (ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or

Art Unit: 1626

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process,..."

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I: Claims 1-3 and 7 drawn to a crystalline polymorph of (+/-)-7-(3-(4-fluorophenyl)-1-(1-methylethyl)-1H-indol-2-yl)-3,5-dihydroxy-6-heptenoic acid monosodium salt and a pharmaceutical composition comprising an effective amount of said compound.

Group II: Claims 4-6, 8-9 drawn to processes of preparation (+/-)-7-(3-(4-fluorophenyl)-1-(1-methylethyl)-1H-indol-2-yl)-3,5-dihydroxy-6-heptenoic acid monosodium salt.

The structural moiety common to Groups I-III is (+/-)-7-(3-(4-fluorophenyl)-1-(1-methylethyl)-1H-indol-2-yl)-3,5-dihydroxy-6-heptenoic acid monosodium salt. This technical feature is not a special technical feature because it fails to define a contribution over the prior art (see WO 2002/36563). Therefore, Claims 1-9 are not so linked as to form a single general inventive concept, and there is lack of unity of invention.

Because the claims do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical features, the claims lack unity of invention and should be limited to a product, a process for the manufacture of said product, **or** a method of use.

Furthermore, with respect to **Groups I-III**, even if unity of invention under 36 CFR 1.475(a) is not lacking, a national stage application, under 37 CFR 1.475(b), containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to only one of the following combinations:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of said product, and a use of said product; or
- (4) A process and an apparatus or means specially designed for carrying out said process; or
- (5) A product, a process specially adapted for the manufacture of said product, and an apparatus or means specially designed for carrying out said process.

Moreover, according to 37 CFR 1.475(c), if an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b), unity of invention might not be present. As a result, the claims lack unity of invention and applicant is required to elect a single invention.

### ***Election***

During a telephone conversation with Applicant's Representative Mervin Wood on 03/09/2007 a provisional election was made *with traverse* to prosecute the invention of Group I, comprising Claims 1-3 and 7. Affirmation of this election must be made by applicant in replying to this Office action.

Applicant's traversal of the lack of unity requirement is not persuasive. As discussed in the lack of unity requirement, the compound (+/-)-7-(3-(-4-fluorophenyl)-1-(1-methylethyl)-1H-indol-2-yl)-3,5dihydroxy-6-heptenoic acid monosodium salt is known in the art (see WO 2002/36563).

***Priority***

The application is a 371 of International Application No. PCT/EP04/52449, filed on 10/06/2004, which claims the benefit of foreign priority under 35 U.S.C. 119, to European Application No. 03103841.7, filed on 10/16/2003. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the European Patent Office on 10/16/2003.

***Information Disclosure Statement***

Applicant's Information Disclosure Statement filed on 8/28/06 has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3 and 7 do not contain sufficient physical data that particularly points out and distinctly claims the product that Applicant regards as his invention. The differences in the X-ray diffraction patterns of different polymorphs are relatively minor, and must be very carefully evaluated before a definitive conclusion is reached (US Pharmacopia, page 1843). There should never be any doubt, in this century, about the chemical identity of a material. PXRD although useful in delineating crystalline structure, does not offer reliable information on chemical identity of a

Art Unit: 1626

material. It is well recognized in the art that powdered X-ray diffraction can be drastically different from its single crystal X-ray (see Bernstein p. 118) and identical PXRD would be obtained for different chemical material were the crystalline structures are identical (see Bernstein p. 272). Further, powdered X-ray diffractogram are well known to contain artifacts. Additionally small changes in relative air humidity can cause small deviations in the d-values of characteristic peaks in the X-ray powder diffraction patterns, which can account for the slight variations in X-ray powder diffraction peaks (see US Pub No. 2003/0032666, paragraph 24). Therefore, in absence of extensive study and correction, "...preferred orientation has significant potential to misguide the analyst ... that changes in the powder X-ray pattern resulted from experimental artifacts rather than polymorphism ..." (Davidovich, p. 16).

***Claim Rejections - 35 USC § 112***

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As stated in the MPEP 2164.01 (a), "There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue."

In In re Wands, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

***The nature of the invention***

The nature of the invention is a composition made with a crystalline polymorphic form of fluvastatin monosodium salt and a pharmaceutically acceptable carrier.

***The state of the prior art and the predictability or lack thereof in the art***

The state of the prior art is that the preparation of compositions requires creating solutions, milling, adding diluents, excipients, surfactants, etc (see p. 3-4 of specification for examples of excipients). The process of preparing a composition, such as a pharmaceutical composition containing a specific crystalline form is complex since polymorphs of a compound can arise when molecules of a compound stack in the solid state in distinct ways. Polymorphs tend to convert from less stable to more stable forms, and the rate of conversion depends on the required activation energy and the difference in free energies. However since small-molecule drugs are flexible, there is no way to tell what a large floppy molecule can do in the solid state except by doing experiments. Generally experiments to find polymorphs reveal the more stable forms first rather than the less stable, metastable polymorph forms. However the ground state usually is the least soluble. Some polymorphs are more difficult to formulate than others because of shape or hygroscopicity, and the importance of ensuring that conversion from one form to another is extremely important (Rouhi, p. 31-32). The process of preparing a pharmaceutical composition will cause a specific crystalline form, if it is in a metastable state to convert back to the most thermodynamically stable form, which is the form with the lowest vapor pressure. This could lead to the disappearance

Art Unit: 1626

of a polymorph form or appearance of a new polymorph. Additionally an acceptable carrier for a pharmaceutical formulation can be water. Dissolving a specific crystalline form in water and forming an aqueous solution would cause the compound to exist in free form rather than a crystalline form with an identifying X-ray diffraction pattern. In such conditions, the use of a wrong polymorph of a drug could cause a phase conversion from the metastable to stable polymorph to occur (Haleblian *et al*, pg. 912).

***The amount of direction or guidance present and the presence or absence  
of working examples***

The specification describes a crystalline polymorphic form of fluvastatin monosodium salt and generic processes for preparing compositions, including possible excipients and methods of administration. However the specification fails to provide results or test data to show that any composition containing the claimed compound, fluvastatin monosodium salt, would retain this specific polymorph and would not result in the conversion to another polymorph, such as the most thermodynamically stable form or the free form of the compound.

***The breadth of the claims***

The instant breadth of the rejected claim is broader than the disclosure, specifically, the instant claim includes a composition made with crystalline polymorphic form of fluvastatin monosodium salt and a pharmaceutically acceptable carrier but fails to disclose if the composition would actually still contain the specific polymorphic form of fluvastatin monosodium salt or a completely different form.

***The quantity or experimentation needed and the level of skill in the art***

While the level of skill in the art is high, one of ordinary skill in the art would be unable to predict or maintain a specific crystalline form in a composition upon its preparation without experimental direction and guidance. The unpredictability of the existence of polymorph forms of a chemical compound, and the interconversion from one metastable form to another stable form under ordinary conditions would cause undue experimentation for one to ascertain what would be contained in the composition, and the exact conditions for its preparation. In view of the breadth of the claim, the chemical nature of the invention and unpredictability of formulating a composition with a crystalline structure of a compound, and the lack of working examples regarding the activity as claimed, one skilled in the art would have to undergo an undue amount of experimentation to make the instantly claimed invention commensurate in scope with the claims. Absent factual data to the contrary, claim 7 is rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph.

***Prior Art Rejections***

In regards to applicants compound claims 1-3 and 7; the prior art references of WO 02/36563 and US Pub No. 2003/0032666 provide X-ray diffraction data very similar to that of applicants' instant invention. The reference discloses Fluvastatin sodium in crystalline form, which puts this product in the public domain. Applicant must show that their crystalline form really is different from any of the ones prepared in the prior art.

Art Unit: 1626

MPEP 2112 states: "Something which is old does not become patentable upon the discovery of a new property. The claiming of a new use, new function or unknown property, which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430,433 (CCPA 1977)." In this case, the "unknown property" is the particular crystalline form or purer version of a currently known crystalline form. This is unknown because the references are silent on the purity of the particular crystalline form. MPEP 2112 goes on to state: "A rejection under 35 USC 102/103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic. Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 USC 102 and 103, expressed as a 102/103 rejection." Again, the "characteristic" which the prior art is silent on is the crystalline form and its purity.

This is not an ordinary inherency situation where it is not explicitly stated what the product actually is. Here the reference explicitly teaches exactly what the compound is. The only difference is a characteristic about which the reference happens to be silent. See also Ex parte Anderson, 21 USPQ 2d 1241 and 1251, discussion of Rejection E. There, the decision states, "There is ample precedent for shifting the burden to an applicant to reproduce a prior art product whose final structure or properties are, at least, in part determined by the precise process used in its manufacture." (page 1253). The "properties" branch of that statement applies here.

Art Unit: 1626

Applicants are reminded that the PTO has no testing facilities. It is noted that the composition claim 7 is rejected under 35 USC 102 as the prior art references disclose compositions comprising applicants' instantly claimed invention as it is the state of the prior art that the preparation of pharmaceutical compositions requires, milling, adding excipients, surfactants, etc. The process of preparing a pharmaceutical composition will cause a specific crystalline form, if in the metastable state, to resort back to the most thermodynamically stable form, which is the form with the lowest vapor pressure. Polymorphs tend to convert from less stable to more stable forms (Rouhi, page 32).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Van der Schaaf *et al* in WO 2002/36563 and Van der Schaaf *et al* in US Pub No. 2003/0032666. Claims 1-3 and 7 are drawn to Fluvastatin monosodium salt with the X-ray powder diffraction powder mentioned above and pharmaceutical composition made from Fluvastatin monosodium salt and a pharmaceutically acceptable carrier.

WO 2002/36563 discloses multiple crystalline compounds of (3R,5S)- or (3S,5R)-7-(3-(-4-fluorophenyl)-1-(1-methylethyl)-1H-indol-2-yl)-3,5dihydroxy-6-heptenoic acid monosodium salt (p. 6-7). In particular, the X-ray powder diffraction of Form D is disclosed to have characteristic peaks expressed in d-values (Å) that include: 30.1,

Art Unit: 1626

10.0, 7.5, 6.2, 5.01, 4.31, 4.13, 3.95, 3.00. These peak values correspond to the values set forth in the instantly claimed invention within a range of  $<0.9$ , except for the absence of the peak at 15.0 of the instantly claimed invention. According to the USP general chapter on x-ray diffraction identification of crystalline materials can be accomplished by comparisons of X-ray powder diffraction patterns obtained for known materials with those of the unknown. For most organic crystals, it is appropriate to record the diffraction pattern to include values for that range from as near zero degrees as possible to 40 degrees (p. 1844). Agreement between sample and reference should be reproducible to 0.20 degrees. Brittain also states that identity is established if the scattering angles of the ten strongest reflections obtained for an analyte agree to within  $\pm 0.20$  degrees with that of the reference material (p. 238). Seven of the nine peaks set forth in the claimed invention fall within  $\pm 0.10$  degrees of that of Fluvastatin sodium Form D. Compositions comprising the claimed compound and possible pharmaceutically acceptable carriers are described on p. 5.

US Pub No. 2003/0032666 discloses multiple crystalline compounds of (+/-)-7-(3-(-4-fluorophenyl)-1-(1-methylethyl)-1H-indol-2-yl)-3,5-dihydroxy-6-heptenoic acid monosodium salt (p. 1). In particular, the X-ray powder diffraction of Form F is disclosed to have characteristic peaks expressed in d-values (Å) that include: 29.6, 14.8, 9.9, 7.4, 6.2, 5.03, 4.35, 3.98, 2.98. These peak values correspond to the values set forth in the instantly claimed invention within a range of  $<0.4$ . The reference teaches that small changes in relative air humidity can cause small deviations in the d-values of characteristic peaks in the X-ray powder diffraction patterns (paragraph 24), which can

Art Unit: 1626

account for the slight variations in X-ray powder diffraction peaks. Compositions comprising the claimed compound and possible pharmaceutically acceptable carriers are described on p. 2. Therefore, claims 1-3 and 7 are rejected under 35 U.S.C. 102(b).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Rejection I:**

Claims 1-3 and 7 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7 and 20 of U.S. Patent No. 6,858,643. Although the patented claim is not identical, it is not patentably distinct from the claim at issue because applicants are claiming a crystalline form of fluvastatin sodium that has characteristic X-ray powder peaks expressed in d-values (Å) that overlap with the peaks of the compound of claim 7.

The difference between the claims at issue and the patented claim is found in the values of the peaks that are found in the claims. The instant claims are drawn to a crystalline compound with

X-ray powder diffraction pattern with characteristic peaks expressed in d-values (Å): 29.2 (w), 15.0 (vw), 10.1 (m), 7.6 (vs), 6.10 (s), 5.09(m), 4.37 (s), 3.83 (w) and 3.07(m), wherein (vs) = very strong intensity, (s) = strong intensity, (m) = medium intensity, (w) = weak intensity and (vw) = very weak intensity.

and a pharmaceutical

composition comprising a said compound and a pharmaceutically acceptable carrier while the patented claim is drawn to a crystalline compound with

its a characteristic X-ray powder diffraction pattern with characteristic peaks expressed in d-values (Å):

30.1 (w), 10.0 (w), 8.6 (w), 8.3 (w), 7.5 (s), 6.5 (w), 6.2 (vw), 6.0 (m), 5.01 (s), 4.83 (m), 4.31 (w), 4.13 (m), 3.95 (w), 3.54 (w), 3.44 (vw), 3.00 (w), wherein (s)=strong intensity; (m)=medium intensity; (w)=weak intensity; and (vw)=very weak intensity.

and a pharmaceutical composition comprising a

said compound and a pharmaceutically acceptable carrier. However, the peak values of those found in the patented claim correspond to the values set forth in the instantly

Art Unit: 1626

claimed invention within a range of  $<0.9$ , except for the absence of the peak at 15.0 of the instantly claimed invention.

Therefore, it would have been obvious in view of US Patent No. 6,858,643 to synthesize applicants' instantly claimed compound and pharmaceutical composition for use as an inhibitor of HMG-CoA to lower blood cholesterol since compounds of similar scope had been administered for the same use. The motivation would be the expectation of success in use of applicants' compounds in treatment of high cholesterol levels.

### **Rejection II:**

Claims 1-3 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-12 of U.S. Patent No. 6,696,479. Although the patented claim is not identical, it is not patentably distinct from the claim at issue because applicants are claiming a crystalline form of fluvastatin sodium that has characteristic X-ray powder peaks expressed in d-values (Å) that overlap with the peaks of the compound of claim 11 and a pharmaceutical composition comprising said compound.

The difference between the claims at issue and the patented claim is found in the values of the peaks that are found in the claims. The instant claims are drawn to a crystalline compound with

X-ray powder diffraction pattern with characteristic peaks expressed in d-values (Å): 29.2 (w), 15.0 (vw), 10.1 (m), 7.6 (vs), 6.10 (s), 5.09(m), 4.37 (s), 3.83 (w) and 3.07(m), wherein (vs) = very strong intensity, (s) = strong intensity, (m) = medium intensity, (w) = weak intensity and (vw) = very weak intensity.

and a pharmaceutical

composition comprising said compound and a pharmaceutically acceptable carrier while

11. A crystalline polymorph of (±)-7-(3-(4-fluorophenyl)-1-(1-methylethyl)-1H-indol-2-yl)-3,5-dihydroxy-6-heptenoic acid monosodium salt which exhibits a characteristic X-ray powder diffraction pattern with characteristic peaks expressed in d-values (Å):

29.6 (w), 14.8 (vw), 9.9 (w), 8.6 (vw), 8.3 (vw), 7.4 (s), 6.6 (vw), 6.2 (vw), 5.93 (w), 5.03 (m), 4.94 (m), 4.35 (vw), 4.23 (w), 3.98 (vw), 3.54 (vw), 2.98 (vw), wherein (s)=strong intensity; (m)=medium intensity; (w)=weak intensity; and (vw)=very weak intensity.

the patented claim is drawn to and a pharmaceutical composition comprising said compound and a pharmaceutically acceptable carrier. However, these peak values correspond to the values set forth in the instantly claimed invention within a range of <0.4.

Therefore, it would have been obvious in view of US Patent No. 6,696,479 to synthesize applicants' instantly claimed compound and pharmaceutical composition for use as an inhibitor of HMG-CoA to lower blood cholesterol since compounds of similar scope had been administered for the same use. The motivation would be the expectation of success in use of applicants' compounds in treatment of high cholesterol levels.

### ***Objections: Content of Specification***

The specification does not incorporate cross reference to related applications. The specification should contain the following sections below, as applicable:

- b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cheng whose telephone number is 571-272-6233. The examiner can normally be reached on M-F, 9AM to 5:30PM EST.

Art Unit: 1626

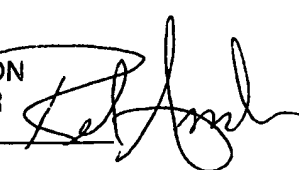
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Karen Cheng  
Patent Examiner, AU 1626

REBECCA ANDERSON  
PATENT EXAMINER



Joseph McKane  
Supervisory Patent Examiner, AU 1626